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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2009-007207
Application 10/675,653
Technology Center 2400

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

Appellants' invention relates generally to information storage. (Spec 1). More particularly, the invention on appeal is directed to a media processing system offering access to newly available media in a media exchange network. (*Id.*).

Representative Claim 1

A method for communication of information in a distributed media network, the method comprising:

detecting availability by at least one media processing system in the distributed media network, of one or more of newly available media, data and service within the distributed media network;

comparing by said at least one media processing system, said one or more of said newly available media, data and service with data in a media profile associated with said at least one media processing system; and

requesting at least a portion of said one or more of said newly available media, data and service from the distributed media network based on said comparison by said at least one media processing system.

Rejections

1. Claims 1-7, 9, 11-17, 19, 21-27, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kikinis (US Pat. 5,644,714).
2. Claims 8, 10, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kikinis and Schwartz (US Pat. 5,913,032).

GROUPING OF CLAIMS

1. Appellants argue claims 1, 11, and 21 as a group (App. Br. 8 *et seq.*). We select representative claim 1 to decide the appeal for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).
2. Appellants argue claims 2, 12, and 22 as a group (App. Br. 11 *et seq.*). We select representative claim 2 to decide the appeal for this group.
3. Appellants argue claims 3, 13, and 23 as a group (App. Br. 12 *et seq.*). We select representative claim 3 to decide the appeal for this group.
4. Appellants argue claims 4, 14, and 24 as a group (App. Br. 13 *et seq.*). We select representative claim 4 to decide the appeal for this group.
5. Appellants argue claims 5, 15, and 25 as a group (App. Br. 15 *et seq.*). We select representative claim 5 to decide the appeal for this group.
6. Appellants argue claims 8, 18, and 28 as a group (App. Br. 17 *et seq.*). We select representative claim 8 to decide the appeal for this group.
7. Appellants argue claims 10, 20, and 30 as a group (App. Br. 19 *et seq.*). We select representative claim 10 to decide the appeal for this group.
8. All claims not argued separately fall with the respective base claim from which they depend. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ANALYSIS

We consider Appellants' arguments *seriatim* as presented in the principal Brief at page 8 *et seq.*

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal regarding representative claim 1:

1. Under § 102, did the Examiner err in finding that Kikinis discloses the following argued limitations:

comparing by said at least one media processing system, said one or more of said newly available media, data and service with data in a media profile associated with said at least one media processing system,

within the meaning of representative claim 1?

FINDINGS OF FACT (FF)

1. Kikinis discloses that “[p]aying clients of the video service, at the time of subscription, specify the topics of their particular interest and provide details of their local receiving equipment, which must be of a type compatible with the worldwide network. Each time a new clipping is made available, file servers in each area send a message to clients who have subscribed to the categories appropriate to the new clipping.” (Col. 4, ll. 10-16).
2. Kikinis discloses that “[c]lients can monitor their service as often as they like for newly available video in the areas of interest they have indicated, and can then select clippings they wish to see.” (Col. 4, ll. 17-19).

ANALYSIS

Independent claims 1, 11, and 21

Appellants present the following principal argument in opposition:

As clearly seen from the above Final Office Action citation, the Examiner has equated Kikinis' file servers 1-7 to Applicant's "media processing system." However, as clarified above, Kikinis' "profile" relates to the subscribing clients 17-39, and the "profile" does not relate to, and it is not associated with, the file servers 1-7 (equated to "media processing systems"). Therefore, Kikinis does not disclose "comparing by said at least one media processing system, said one or more of said newly available media, data and service with data in a media profile associated with said at least one media processing system," as recited by the Applicant in independent claim 1.

(App. Br. 9-10).

The Examiner disagrees, as follows:

[I]t is noted that the claim language "associated with said at least one media processing system" is very broad. Almost anything related to the media processing system in any way is "associated with" it. In this case, Kikinis teaches that clients of the video service provide information to the file servers, including the details of their receiving equipment and topics of interest (col. 4, ll. 10-13). This information is subsequently used, *by the file servers*, to determine when to notify a particular subscriber of newly available media (col. 4, ll. 14-16; col. 5, ll. 34-36).

(Ans. 8).

At the outset, we conclude that nothing in the language of representative claim 1 limits the “media processing system” to reading on only a server. Instead, we conclude that the claimed “media processing system” broadly but reasonably reads on any element in a distributed media network that performs the claimed functions of detecting and comparing. (Claim 1). Moreover, we broadly but reasonably construe the claim term “associated with” as reading on *any* nexus between a media profile and media processing system – even an attenuated nexus.¹ Given this construction, we agree with the Examiner that “[a]lmost anything related to the media processing system in any way is ‘associated with’ it.” (Ans. 8). Therefore, we find unpersuasive each of Appellants arguments that is premised on the view that there is no anticipation because the profile in Kikinis is only associated with the subscribing clients. (e.g., App. Br. 9). On this record, we agree that the Examiner’s claim construction falls well within the broadest reasonable interpretation of Appellants’ claim 1.

For these reasons, we find Appellants have not met their burden of showing reversible error in the Examiner’s *prima facie* case of anticipation

¹ Appellants’ claims are given their broadest reasonable interpretation consistent with the Specification, and the claim language is read in light of the Specification as it would have been interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

for claim 1.² Therefore, we sustain the §102 rejection of representative claim 1, and claims 11 and 21 which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

Claims 2, 12, and 22

Representative claim 2 recites:

The method according to claim 1, comprising receiving said requested at least a portion of said one or more of said newly available media, data and service by said at least one media processing system, if said one or more of said newly available media, data and service *matches* said data in said media profile associated with said at least one media processing system.

(emphasis added).

As pointed out by the Examiner, Appellants' arguments for these claims are substantially identical to those previously presented for claim 1, which we did not find to be persuasive. (Ans. 9). Moreover, we find a

² See *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“Jung argues that the Board gave improper deference to the examiner’s rejection by requiring Jung to ‘identif[y] a reversible error’ by the examiner, which improperly shifted the burden of proving patentability onto Jung. *Decision* at 11. This is a hollow argument, because, as discussed above, the examiner established a *prima facie* case of anticipation and the burden was properly shifted to Jung to rebut it. . . . ‘[R]everisible error’ means that the applicant must identify to the Board what the examiner did wrong . . .’”).

matching of the paying client profile (i.e., topics of their particular interest) must inherently occur in order for “[e]ach time a new clipping is made available, file servers in each area send a message to clients who have subscribed to the categories appropriate to the new clipping.” (Kikinis - FF 1).

For these reasons, we find Appellants have not met their burden of showing reversible error in the Examiner’s prima facie case of anticipation for claim 2. Therefore, we sustain the §102 rejection of representative claim 2, and claims 12 and 22 which fall therewith. *See 37 C.F.R. §41.37(c)(1)(vii).*

Claims 3, 13, and 23

Representative claim 3 recites: “The method according to claim 1, wherein said data in said media profile associated with said at least one media processing system is *predefined*.” (emphasis added).

Appellants contend that Kikinis does not disclose that the data in the media profile associated with the media processing system is predefined. (App. Br. 12). However, we disagree, as the medial profile of Kikinis is at least initially “predefined” when “[p]aying clients of the video service, *at the time of subscription, specify the topics* of their particular interest and provide details of their local receiving equipment . . .” (FF 1)(emphasis added).

For this reason, we find Appellants have not met their burden of showing reversible error in the Examiner’s prima facie case of anticipation for claim 3. Therefore, we sustain the §102 rejection of representative claim 3, and claims 13 and 23 which fall therewith. *See 37 C.F.R. §41.37(c)(1)(vii).*

Claims 4, 14, and 24

Representative claim 4 recites: “[t]he method according to claim 1, comprising dynamically updating data in said media profile associated with said at least one media processing system.”

Appellants aver that “[e]ven if we assume for the sake of argument that Kikinis discloses a media profile associated with at least one media processing system . . . the Examiner's argument is still deficient. Namely, Kikinis only discloses that the profile is only set up at the time of subscription and Kikinis does not disclose any dynamic updating of the profiles, as recited in Appellant's claims 4, 14, and 24.” (App. Br. 14)..

However, we find the evidence supports the Examiner's position that “[s]ince there are numerous clients server by Kikinis' system (fig. 1), each time a new subscriber joins, their subscription information is added to the media server's profile, *dynamically updating* it with the information needed to notify the new subscriber of new content.” (Ans. 9; *see also* FF 1)(emphasis added).

We also observe that Appellants do not directly respond to the Examiner's findings in the Reply Brief. Instead, Appellants merely restate that there is no anticipation because the profile in Kikinis is only associated with the subscribing clients. (Reply Brief, 7). We find this argument unconvincing for the same reasons discussed above regarding claim 1.

On this record, we find Appellants have not met their burden of showing reversible error in the Examiner's prima facie case of anticipation for claim 4. Therefore, we sustain the §102 rejection of representative claim 4, and claims 14 and 24 which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

Claims 5, 15, and 25

Representative claim 5 recites: “The method according to claim 1, comprising *polling* at least one of a plurality of network components in the distributed media network for said one or more of said newly available media, data and service.” (emphasis added).

Appellants point to the portions of the reference relied on by the Examiner and contend that “Kikinis, including col. 4, lines 17-20, does not disclose any polling for newly available media, data and/or service, as recited by the Applicant in claims 5, 15, and 25.” (App. Br. 15).

The Examiner disagrees. The Examiner finds that

Kikinis discloses that clients monitor their service "as often as they like" for newly available video (col. 4, ll. 17-20[; *see also* FF 2]). Monitoring the service "as often as they like" requires that the clients control the monitoring frequency, which requires that the client poll for newly available content.

Furthermore, Kikinis also discloses that the clients can select clippings they wish to see, which will cause the video data to be sent to the client (col. 4, II. 19-20). This requesting of a media item is also "polling ... for said newly available media".

(Ans. 9-10).

Appellants provide no additional response to the Examiner's findings in the Reply Brief. (p. 7).

We conclude that claim 5 places no restriction on who or what performs the claimed polling. Therefore, for essentially the same reasons argued by the Examiner (Ans. 9-10; FF 2), we agree that the disputed polling is performed when the clients in Kikinis "monitor their service as often as

they like for newly available video in the areas of interest they have indicated, and can then select clippings they wish to see.” (FF 2).

On this record, we find Appellants have not met their burden of showing reversible error in the Examiner’s prima facie case of anticipation of claim 5. Therefore, we sustain the §102 rejection of representative claim 5, and claims 15 and 25 which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

Claims 8, 18, and 28 (§ 103)

Representative claim 8 recites: “The method according to claim 1, wherein said detecting comprises searching by said at least one media processing system of at least another media processing system in the distributed media network for said one or more of said newly available media, data and service.”

Appellants aver that

[w]hile Schwartz discloses that the Object Exchange facilitates exchange of shared data, Schwartz, including col. 6, lines 36-40 and col. 11, lines 21-26, does not disclose that a media processing system (or a user) can search another media processing system (or another user) for newly available media, data and/or service, as recited by the Applicant in claims 8, 18, and 28.

(App. Br. 18-19).

The Examiner disagrees. The Examiner notes that

the rejection is based on the combination of Kikinis and Schwartz. When considered in combination with Kikinis’ sharing of media files by sending files at regular intervals (Kikinis: col. 3, l. 66 to col. 4, l. 5), the object exchange system

of Schwartz would have suggested to one of ordinary skill in the art that would have been advantageous to allow the media servers to search other servers to locate newly available media, to provide an additional means for locating media and allowing servers to locate media files using specific criteria, rather than simply receiving a bulk delivery of all newly available media.

Appellants arguments attack the references individually, concentrating exclusively on Schwartz.

(Ans. 10-11).

We agree with the Examiner that Appellants are attacking Schwartz in isolation when the rejection is based upon the combination of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.).

Therefore, we find Appellants have not met their burden of showing reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness for representative claim 8. Accordingly, we sustain the §103 rejection of claim 8, and claims 18 and 28 which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

Claims 10, 20, and 30 (§ 103)

Representative claim 10 recites:

The method according to claim 1, wherein said detecting comprises *polling* at least another media processing system for said one or more of said newly available media, data and service within the distributed media network, and wherein said at least another media processing system is

authorized for said polling by said at least one media processing system.

Appellants contend that the combination of Kikinis and Schwartz does not teach or suggest the claimed authorized polling of another media processing system. (App. Br. 20-21).

We have addressed the monitoring (polling) feature of Kikinis *supra*. We also observe that Schwartz expressly teaches polling in col. 6, ll. 36-40, as pointed out by the Examiner. (Ans. 7). Because any monitoring or polling that actually occurs is necessarily authorized, we do not find Appellants' arguments persuasive in light of the combined teachings of Kikinis and Schwartz.

On this record, we find Appellants have not met their burden of showing reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness for representative claim 10. Therefore, we sustain the §103 rejection of representative claim 10, and claims 20 and 30 which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

All remaining claims not argued separately fall with the base claim from which they depend. *See* 37 C.F.R. § 41.37(c)(1)(vii).

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DECISION

We affirm the Examiner's § 102 rejection of claims 1-7, 9, 11-17, 19, 21-27, and 29.

We affirm the Examiner's § 103 rejection of claims 8, 10, 18, 20, 28, and 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED

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